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EXAMINER

EVANS, KIMBERLY L

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/573,151	Applicant(s) WISELY, DAVID	
	Examiner KIMBERLY EVANS	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/30/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on March 23, 2006.
2. In reference to communication received on March 23, 2006, where applicant identifies claims 57-95 "...This listing of claims will replace all prior versions, and listings, of claims in the application....", claims 1-56 are hereby deemed cancelled.
3. Claims 57-95 are currently pending and have been examined.

Information Disclosure Statement

4. The Information Disclosure Statement filed on April 30, 2007 has been considered. An initialed copy is enclosed herewith.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do

not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process (also a method) claim to pass muster, the recited process must somehow apply, involve, use or advance the technological arts.

7. Claims 57-95 do not qualify as a statutory process since they recite purely mental steps. To qualify as a § 101 statutory process, the claims should positively recite the other statutory class (thing or product) to which it is tied. For example, by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.
8. Claims 57-95 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The aforementioned claims are directed toward providing information in relation to an electronic communication device via a data signal. However, under the current guidelines of 35 USC 101, computer software must be tangibly embodied on a computer readable medium, and, when executed by a computer processor, perform the steps of the software. In their broadest reasonable interpretation and in light of the specification, claims 57-95 as recited, can be interpreted to be embodied on abstract mediums such as carrier waves and signals, and therefore not eligible for patent protection. Accordingly, these claims are not eligible for patent protection.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 57 recites the limitation "said permanent user identifier" in the first sentence of limitation eight (8). There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 57-95 are rejected under 35 U.S.C. 102(b) as being anticipated by Mikurak US Patent Application Publication No. US 2006/0178918 A1.

13. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

14. With respect to Claims 57 and 86,
Mikurak discloses the following limitations,

- *generating a search request for the item at a user terminal during an initial search session, the search request being associated with said user identity;*
(see at least Abstract: "...searching capabilities are provided utilizing the network in addition to logging events and passive user profiling. The event logging includes logging network operations. User profile data is automatically received and stored. User profile data includes user identity, state, preferences and interests....")
- *modifying the search request to indicate at least one user preference associated with said user identity;* (see at least Abstract: "...User profile data is also automatically exported to an active profile manager which automatically adds additional user profile data. Additional user profile data includes information related to whether the user is a service provider or a manufacturer and the location of user..."; paragraph 173: "...Also displayed is a total price of the items that are selected along with shipping information. During use, the user is allowed to modify the predetermined set of items that are selected. Further, several sets of items may be separately stored for later review and modification...")
- *forwarding the search request to a server adapted to retrieve data from the distributed computer system,* (see at least "Order Management", Figure 9, paragraph 255: "...When a request for an order is received from a service provider in operation 902, the request is subsequently transmitted to one or more manufacturers in operation 904...")
- *retrieving the data from the distributed computer system* (see at least paragraph 255: ".... A network is utilized in operation 906 to receive information from the manufacturer relating to the status of the completing of the order by the manufacturer....")

- *associating the retrieved data with said permanent user identity (see at least Abstract: "...User profile data is automatically received and stored. User profile data includes user identity, state, preferences and interests. User profile data is also automatically exported to an active profile manager which automatically adds additional user profile data...")*
- *providing a search result comprising said retrieved data associated with said user identity to a user terminal selected in accordance with a predetermined user preference dependent on the extent to which the search result conforms with the search request (see at least Figure 54, paragraph 64, paragraph 814, "Commerce-Related Web Application Services": "...in operations 5402 and 5404, data, i.e. specifications, details, etc., relating to the products and services are displayed along with a comparison between different products and services. Data relating to needs of a user may also be received for the purpose of outputting a recommendation of the products and services based on the inputted needs...")*
- *said retrieved data comprises an item conforming to the search criteria of the search request, (see at least Figures 54 and 55, paragraph 871: "...one embodiment of the electronic commerce component of the present invention is provided for facilitating a virtual shopping transaction. First, a plurality of items, i.e. products or services, are selected from a database and displayed for purchase in operation 5500. Preferably, the items are displayed in an electronic catalog format. Next, in operation 5502, a user is allowed to select a predetermined set of the items for purchase. ... The selected items are preferably stored in a database unique to the user. The set of items selected during each shopping session should be stored in a separate listing or file so that the user can individually select particular sets of items...")*

- *performing said further action on said retrieved data in accordance with said at least one said user preference, wherein said further action comprises the purchase of the item at a cost informed by the data retrieved by the search result (see at least Figures 54 and 55, paragraph 871: "...one embodiment of the electronic commerce component of the present invention is provided for facilitating a virtual shopping transaction. First, a plurality of items, i.e. products or services, are selected from a database and displayed for purchase in operation 5500. Preferably, the items are displayed in an electronic catalog format. Next, in operation 5502, a user is allowed to select a predetermined set of the items for purchase.")*
- *the association of said search result with said permanent user identifier enables said search result data to be retrieved by said user after the initial search session has terminated. (see at least Figure 55, "Shopping Cart", paragraph 866: "...Saves shopping carts to be retrieved at later point; paragraph 871: "...Such predetermined set of items is then stored in operation 5506, thereby allowing the user to collectively select the predetermined set of items at a later time without having to select each of the items individually. Note operation 5508. The selected items are preferably stored in a database unique to the user. The set of items selected during each shopping session should be stored in a separate listing or file so that the user can individually select particular sets of items. Optionally, the user may be allowed to name each stored set of items for easier identification later. The user may also be permitted to rate or rank the items of a selected set for purposes of refreshing the user's memory when the user later retrieves the set...")*

15. With respect to Claim 58,

Mikurak discloses the following limitations,

- *a user preference includes financial information personal to the user and another user preference indicates at least one criteria which a search result must conform which*

initiates said further action, (see at least paragraph 815: "...the displayed catalog may be customized based upon the user profile... the data relating to at least one of the products and services may include a link to related data. The comparison between different products and services could include a comparison to a competitor's product. Alternatively, the comparison between different products and services could include identification of at least one advantage of the at least one of products and services. Optionally, the recommendation of at least one of the products and services includes a financial analysis of at least one of the products and services. The features of at least one of the products and services may be generated by a product configuration. The advertising could include customized advertising based upon the user profile..."; paragraph 919: "...It is further desirable for the merchant to transmit information, including a subset of the information provided by the customer, over such a network to a payment gateway computer system that is designated, by a bank or other financial institution that has the responsibility of providing payment on behalf of the customer, to authorize a commercial transaction on behalf of such a financial institution, without the risk of exposing that information to interception by third parties. Such institutions include, for example, financial institutions offering credit or debit card services...")

- *said further action comprises the automatic purchase of the item prior to the user being informed of the search result*. (see at least Figure 143, paragraph 153: "...a block diagram of a bill pay system where billers initiate automatic debits from consumers' bank accounts; paragraph 2431: "...Automated Inventory Management. In some cases, trading partners may set up Automatic Ordering based on usage or schedule. If inventory is used on a regular basis, the re-ordering process may be automated..."; paragraph 2830: "...Consumer C can send bill pay order 14208 in any number of ways... However this is done, service bureau S receives one or more bill pay orders from consumer C. These

orders could be instructions to pay some amount for a bill or a set amount of money at periodic intervals...")

16. With respect to Claim 59,

Mikurak discloses the following limitations,

- *the search result is provided in a medium and format selected by the user for a user terminal to which the search result is to be forwarded* (see at least paragraph 286: "... In packet switching networks, packets in the form of units of data are transmitted from a source--such as a user terminal, computer, application program within a computer, or other data handling or data communication device--to a destination, which may be simply another data handling or data communication device of the same character. The devices themselves typically are referred to as users, in the context of the network. Blocks or frames of data are transmitted over a link along a path between nodes of the network. Each block consists of a packet together with control information in the form of a header and a trailer which are added to the packet as it exits the respective node. The header typically contains, in addition to the destination address field, a number of subfields such as operation code, source address, sequence number, and length code. The trailer is typically a technique for generating redundancy checks, such as a cyclic redundancy code for detecting errors. At the other end of the link, the receiving node strips off the control information, performs the required synchronization and error detection, and reinserts the control information onto the departing packet..."; paragraph 290: "...the format of the data delivered to a party, the rate of delivery of the data, and resequencing of packets received out of order, is generally handled in an organized manner using layered communication architectures. Such architectures address the two portions of the communications problem, one being that the delivery of data by an end user to the communication network should be such that the data arriving at the destination is correct and timely, and the other being that the delivered data must be recognizable and in

proper form for use. These two portions are handled by protocols, or standard conventions for communication intelligently, the first by network protocols and the second by higher level protocols. Each of these protocols has a series of layers...”)

17. With respect to Claim 60,

Mikurak discloses the following limitations,

- *the unique user identity is a session initiation protocol (SIP) user identity* (see at least Rules Database Server, paragraphs 378-404: “...Determines Subscriber Profile [0379] Session requirements such as Bandwidth, Quality Of Service, Class Of Service [0380] Routing preferences based on Priority, Cost, Termination Location [0381] Media and Application requirements (Voice Telephone to Video Telephone, Multi-point, text to speech, Fax to E-mail etc.) [0382] Content Separation (Example: Tells the intelligent peripheral and protocol converter to separate the Audio stream from the data and video stream on an H.32x call; It may also instruct the protocol converter to process the stream so as to enable this audio stream to be fed to a destination which supports traditional analog voice hence the G.728/9 content from the H.32x session would be converted first to AD/PCM and then sent to a Class 5 circuit based switch and terminated on a circuit switched SS7 network POTS line) Access Device (Session Control) [0383] Provides connectivity and session termination from customer premises to the NGN [0384] Acts as the hub for the various applications (Video, Voice, Fax, Web Data, Unified Messaging) [0385] Provides systems management and reporting functions [0386] May provide application multiplexing (allowing simultaneous multi application access) Intelligent Peripheral (Media Control) [0387] Provides services such as DTMF parsing, Voice prompting, Messaging, Speech recognition, Text to Speech, Text to Fax, etc. Protocol Conversion (Policy Management) [0388] Receives session requirements from Rules database [0389] Selects and executes required filters to enable activation, processing and tear-down of sessions [0390] Interfaces with existing CORE network to process

information across NGN/Extended CORE [0391] Filters and Converts signals from SS7 /ISDN to TCP/IP/H.323 [0392] Converts Signaling data from one format to another (example: G.728/9 to AD/PCM or Vocaltec to Vienna Systems, etc.) Network Access Control Point (Session Control) [0393] Similar to a switching node on an SS7 circuit switched network. [0394] First or Last Access Point in the network [0395] Provides actual call/session handling, routing and processing based on instructions from the Rules Database server Session Manager/Event Logger (Session Control..."; paragraph 396: "...this process or application is critical since it is the "glue" between the end user application and the communications network. It is responsible for collection and distribution of end-user session preferences, application requirements, access device capability...")

- *said item is purchased at a time when the user is not in communication with the proxy server* (see at least paragraph 2431: "...Automated Inventory Management. In some cases, trading partners may set up Automatic Ordering based on usage or schedule. If inventory is used on a regular basis, the re-ordering process may be automated..."; paragraph 2830: "...Consumer C can send bill pay order 14208 in any number of ways... However this is done, service bureau S receives one or more bill pay orders from consumer C. These orders could be instructions to pay some amount for a bill or a set amount of money at periodic intervals...")

18. With respect to Claim 61,

Mikurak discloses the following limitations

- *the data includes an item and associated cost information* (see at least Figure 60, paragraph 899: "...Each of the items includes a plurality of available features which are displayed in operation 6003, preferably with the price of each feature, including cost for adding the feature and cost savings for removing the feature. Next, a user is permitted to

select the available features of each of the items to be purchased, as indicated in operation 6004...")

- *the distributed computer system comprises at least one user terminal capable of communicating with a proxy server* (see at least Figures, and 28 1, paragraph156: "...a typical hardware configuration of a workstation in accordance with one embodiment having a central processing unit 110, such as a microprocessor, and a number of other units interconnected via a system bus 112. The workstation shown in FIG. 1 includes a Random Access Memory (RAM) 114, Read Only Memory (ROM) 116, an I/O adapter 118 for connecting peripheral devices such as disk storage units 120 to the bus 112, a user interface adapter 122 for connecting a keyboard 124, a mouse 126, a speaker 128, a microphone 132, and/or other user interface devices such as a touch screen (not shown) to the bus 112, communication adapter 134 for connecting the workstation to a communication network 135 (e.g., a data processing network) and a display adapter 136 for connecting the bus 112 to a display device 138...")
- *the proxy server being capable of communicating with at least one other server capable of retrieving information from the distributed computer system,* (see at least paragraph 280: "...computing environment where all systems act as both the client and server, more of the data flow will follow a peer-to-peer model. The network will be required to provide more direct access to all peers wishing to use high-performance backbone internets connecting, for example, the desktop computers...")
- *the user terminal being adapted to be operable by a user who is registered with the proxy server with an identifier for the user,* (see at least paragraph 377: "...a user's profile may be physically stored in a Rules database in the United States, the user may access the network from Europe and be automatically granted access to the specific

services and features that normally would be available during his US service experience. The remote session controller in Europe would communicate with the cross network location register and rules database server to identify the subscriber's "home" rules database in order to collect the policies and profile of the subscriber for use in Europe; this is done by using the inter device message sets (command and control) over the control plane sub network...")

- *the identifier being associated with one or more static or dynamic addresses, the user identifier being further associated with a set of user preferences* (see at least, paragraph 1721 and 1722: "...Supports Server Information with URL Session Identifiers .." paragraph 1722: "...the internet services component of the present invention may provide a mechanism to note and remember one or more preceding events in a given sequence of interactions with the user or application program. State and session information may be tracked. Multiple independent user sessions that are simultaneously active may be managed. Support is provided for user cookies, server information with user cookies, client URL encoding, and server information with URL session identifiers....")
- *said step of generating a search request at said user terminal comprises: indicating at least one search criterion to be met by the data to be retrieved* (see at least paragraph 1132: "..., a search engine could select relevant questions based on a user's input criteria...")
- *sending a search request message encapsulating the search request to the proxy server* (see at least paragraph 159: "...This concept of packaging data, structures, and procedures together in one component or module is called encapsulation...."; paragraph 617: "...Direct delivery is the transmission of a datagram from one machine across a single physical network to another machine on the same physical network. Such

deliveries do not involve routers. Instead, the sender encapsulates the datagram in a physical frame, addresses it, and then sends the frame directly to the destination machine...."; paragraph 2655: "...Users will see a different default store depending on their particular interests and corresponding profiles. The customer is able to view all products in an encapsulated format where limited product information is shown..."")

- *said step of modifying the search request incorporates the user preferences and associates the search request message with the identifier of the user* (see at least paragraph 872: "...During use, the user is allowed to modify the predetermined set of items that are selected. Further, several sets of items may be separately stored for later review and modification...")
- *forwarding the modified search request message and the identifier from the proxy server to at least one search server arranged to process the received search request message;* see at least HTTP--Page Rendering paragraph 1692: "...Serves requested web pages and graphics from web servers to client web browsers..")
- *performing a search according to the encapsulated search request* (see at least Figure 121, paragraph 3026: "...Users will see a different default store depending on their particular interests and corresponding profiles....")
- *sending a search result containing some information dependent on the identifier for the user encapsulated in a search result message to the proxy server;* (see at least Figure 121, paragraph 3026: "...The customer is able to view all products in an encapsulated format where limited product information is shown.")

- *de-encapsulating the search result message*; (see at least Figure 121, paragraph 3026: "...When a product is selected, descriptions, pricing, incentives, and other details can be shown...")
- *processing the search result according to the set of user preferences* (see at least Figure 121, paragraph 3026: "...The customer can place items in a shopping basket, as well as viewing and deleting items already in the basket...")
- *selecting one of said at least one user terminals according to the set of user preferences*; (see at least paragraph 286: "...packets in the form of units of data are transmitted from a source--such as a user terminal, computer, application program within a computer, or other data handling or data communication device--to a destination, which may be simply another data handling or data communication device of the same character...")
- *sending an search result message encapsulating the processed search result to said at least one selected user terminal* (see at least paragraph 883: "...Such information may be input directly by the user, captured as a user uses the network, and may be downloaded periodically from a user's system. Next, in operation 5601, a plurality of items for purchase are displayed, from which the customer is allowed to select multiple, similar items, i.e. products or services to compare in operation 5602. Then, after a set of features of each item is determined in operation 5603, operation 5604 creates a hierarchy of the features of the items selected in accordance with the customer's profile...")

19. With respect to Claim 62,
Mikurak discloses the following limitations

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- *including the step of the proxy server purchasing the item at the cost indicated by the search result and modifying' the search result to indicate the item has been already purchased, if at least one predetermined user preference indicates personal financial information of the user which enables the purchase transaction to be completed by the proxy server, the proxy server being configured to automatically purchase an item at a designated cost if at least one user preference indicates that an automatic purchase can occur if the search result meets at least one predetermined search criterion. (see at least Figure 142, paragraph 2431: "...Automated Inventory Management. In some cases, trading partners may set up Automatic Ordering based on usage or schedule. If inventory is used on a regular basis, the re-ordering process may be automated...; paragraph 2830: "...Consumer C can send bill pay order 14208 in any number of ways, such as using a personal computer and modem, directly or through a packet of other data network, via an automatic teller machine (ATM), video touch screen, a screen phone, or telephone Touch-Tone.TM. pad (TTP) interacting with a voice response unit (VRU). However this is done, service bureau S receives one or more bill pay orders from consumer C. These orders could be instructions to pay some amount for a bill or a set amount of money at periodic intervals...")*

20. With respect to Claim 63,

Mikurak discloses the following limitations

- *the distributed computer system supports the session initiation protocol (SIP), and wherein the user terminal is a SIP registered terminal, the proxy server is a SIP proxy server, and the user is registered at the proxy server with a unique SIP address (see at least 902-905: "... Netscape Communications uses its Navigator/Netsite World Wide Web (WWW) browser /server pair. A buyer uses a Navigator to select a seller's Netsite server (sort of an electronic storefront), which is in turn coupled to standard application servers (back-end subsystems), e.g., a credit server or a member server for collecting*

demographic information on customers. These servers contain the business rules defined by the seller, e.g., what credit cards are accepted and what customer information is tracked during each sale. Some of these servers are connected to external, third-party services, e.g., the credit server to an external credit card processing network or the member server to an external demographics processing module. The actual applications e.g., on-line publishing or catalog sales, are represented as extensions of the application servers. Equivalently, the application servers are said to be instantiated in the applications. The net result of this approach is that the business rules (from the application servers) are embedded into the applications along with the application logic or presentation...;paragraph 905: "...database or file-based shopping cart systems require that the user be uniquely identified in order to associate particular data stored on the server with a particular user. This requires the user to log-in or create an account, which is then stored in the server. Each subsequent request from the user must reference the unique identifier, either in the uniform resource locator (URL) or as hidden data passed back through a form submission. Either of these approaches require that the account or ID information of the user be stored on the remote server in the network for some definite period of time. Usually, the user must keep track of the account identifier in order that the prior session information can be retrieved....")

21. With respect to Claim 64,

Mikurak discloses the following limitations

- *the search result message is a SIP message which is sent to the user at an address determined by the SIP proxy server to be the current location of the user who requested the search.* (see at least State and Session management, paragraphs 1715-1722: "...Supports Client URL Encoding :Supports Server Information with Client Cookies [1721] Supports Server Information with URL Session Identifiers [1722] The internet services component of the present invention may provide a mechanism to note and

remember one or more preceding events in a given sequence of interactions with the user or application program. State and session information may be tracked. Multiple independent user sessions that are simultaneously active may be managed. Support is provided for user cookies, server information with user cookies, client URL encoding, and server information with URL session identifiers...; paragraph 2593: "...Authentication services are provided to users at customer locations with digital certificates. The central corporate headquarters will maintain a CA (Certificate Authority) to administer the certificates. The CA is integrated with an LDAP server to store directory information. An RA (Registration Authority) is used to process certificate requests. For users at customer locations, the authentication occurs at the corporate web server and is managed by the web server access control software. Stronger authentication is required for remote users because they have increased access in the internal network. Remote users therefore will be issued smart cards on which they will store their private key. Each remote user will need a smart card reader for their PC..."")

22. With respect to Claim 65,

Mikurak discloses the following limitations

- *the identifier comprises the user's registered SIP identity and the search result SIP message is sent to a plurality of addresses associated with the user's registered SIP identity.* (see at least claim 32: "...A system for a computerized framework manager to supply collaborative planning comprising: (a) a module for providing connections to a network for use by a plurality of business entities, wherein the first and second business entities comprise at least one of service providers, vendors, resellers, and manufacturers; (b) a module for receiving information via the network from a first business entity_of the plurality of business entities, including information relating to a demand of the first independent business entity for offerings; (c) a module for receiving information via the

network from a second business entity of the plurality of business entities, including information relating to a supply of offerings from the second business entity...")

23. With respect to Claim 66,

Mikurak discloses the following limitations

- *the search result SIP message is sent to an address associated with a different user terminal than the user terminal operated by the user to send the search request to the SIP proxy server* (see at least Figure 53, Network Services: paragraph 1655: "...As shown in component 5316 of FIG. 53, one embodiment of the present invention is provided for controlling the network and managing resources. More detail is provided in FIG. 77. Features include caching of network content in operation 7700, providing application proxy services the network in operation 7702, managing resources and load balancing such as spreading tasks among servers and rerouting around problems in operation 7704, and managing network objects in operation 7706. Operation 7708 controls at least one of bandwidth and speed of the network. Remote log in and access is provided in operation 7710, and affording firewall services on the network in operation 7712..."; paragraph 1663, referring to Application Proxy Services: "...The network services component of the present invention passes requests from external clients to internal web servers and returns results. This component may also serve as trusted agent to access machines on the behalf of clients, particularly useful for automatic upgrades or information downloading for offline use. Optionally, IP Addresses of machines may be hidden from external clients. Further, configuration control may be provided over access permissions. As another option, reverse proxy services could be provided...")

24. With respect to Claim 67,

Mikurak discloses the following limitations

- *the user terminal is a mobile device.*(see at least paragraph 405: "...These wireless access methods to the "New Core" will be restricted to lower speeds due to the legacy nature of this wireless infrastructure while new broadband wireless access may emerge to provide a new set of IP enabled wireless devices that can provide broadband services over wireless/mobile devices...")

25. With respect to Claim 68,

Mikurak discloses the following limitations

- *the set of user preferences comprises a formatting user preference which indicates how the search result should be formatted.* (see at least paragraph 857: "...Preferably, the default setting of the display catalog would be preset, but the display format of the display catalog would be customizable based on user preference or automatically based on user profile. For example, the user may be permitted to customize the format of the display catalog for his or her particular session, or the customizations may be saved so that the user's personalized settings are used each time the display catalog is opened by that particular user. The display format may also be customized to display localized content, such as by being based on the location of the user...")

26. With respect to Claim 69,

Mikurak discloses the following limitations

- wherein the set of user preferences comprises a plurality of formatting user preferences, each formatting user preference being associated with a type of user terminal. (see at least paragraph 857: "...the customizations may be saved so that the user's personalized settings are used each time the display catalog is opened by that particular user...";

paragraph 2412: "...display the merchandise in the same format so it is as appealing as when they order it...")

27. With respect to Claims 70 - 74,

Mikurak discloses the following limitations

- *the method further comprises the step of the proxy server modifying the set of at least one search criterion according to said set of user preferences.*
- *at least one user preference indicates a scheme to which the user has subscribed which may modify the cost of an item returned by the search. (see at least paragraph 2405: "...the ability to review, update, and cancel the order at any time may be allowed...")*
- *the method further comprises the step of the proxy server modifying the search result according to a set of user preferences.*
- *the proxy server software modifies the search result by modifying the cost of an item returned according to a pricing scheme to which the user has subscribed.*
- *the proxy server software modifies the search result by modifying the cost of an item returned according to a pricing scheme provided by the proxy server software.*

(see at least paragraphs 2408 – 2413, Shopping Cart Metaphor, Figure 108, paragraph 2408: "...Each implementation will require specific flow and business logic. The commerce packages available today provide generic order processing business capabilities that will need to be customized to achieve the specific needs of the business. Illustrated in FIG. 108 is an example flow of business capabilities needed for complete order processing on an eCommerce implementation. The process begins with operation 10800 which allows browsing and interacting in order to permit selection of merchandise in operation 10802. The process ends in operation 10804 with settlement...."; paragraph 2410: "...Shopping Cart Metaphor--The user is enabled to select items and add them to his online shopping cart. The items selected will be tracked. The user has the ability to add or remove items, review item details, and check out and total the items. In addition, the shopping cart should allow the user

to exit and reenter the store without losing the items he has selected...."; paragraph 2413: "...The customer should be able to save and recall items, pricing, and other order details for the current and previous orders...")

28. With respect to Claim 75,

Mikurak discloses the following limitations

- *the at least one search server to which said search request message is forwarded to by the proxy server is determined by the proxy server in accordance with said set of at least one user preferences. (see at least paragraph 2212: "...the information pushed from a server to a user actually comes as the result of a subscription-like standing request created by the user and either stored on the server or on their local machine. This program captures and stores the user's profile locally and then periodically initiates requests for information on the user's behalf from the server....")*

29. With respect to Claim 76,

Mikurak discloses the following limitations

- *the proxy server modifies the search result received to identify an address to which the search request can be forwarded to in the form of an electronic email. (see at least paragraph 2128: "...Interested buyers can place a bid online and see how their bid price compares with others. The auctions are time based and follow a detailed bidding process. As customers are out bid, they are notified via email and have the option to reply with a counter bid...")*

30. With respect to Claim 77,

Mikurak discloses the following limitations

- *the proxy server processes the returned search result to remove at least one result which is indicated by at least one user preference as not relevant to the user's listed interests.* (see at least Figure 94, paragraph 2153: "...FIG. 94 illustrates a flowchart for a method 9400 for suggesting products over a network. Information of a product is displayed in operation 9402. The product information includes product specifications, graphics, video images, digital samples, and/or inventory availability. In operation 9404, a search mechanism is provided for searching for items similar to the product over a network. Items found during the search similar to the product are suggested in operation 9406. Selection of the product and the items similar to the product is allowed for purchase over the network in operation 9408..."; paragraph 2410: "...The user has the ability to add or remove items, review item details, and check out and total the items. In addition, the shopping cart should allow the user to exit and reenter the store without losing the items he has selected...")

31. With respect to Claim 78,

Mikurak discloses the following limitations

- *the proxy server processes the returned search result to modify any returned cost value for an item indicated by the search according to a discount scheme to which the identity of the user is associated.* (see at least paragraph 2172: "...the pricing mechanism should be tied to any sort of discounting or promotional incentives. For Business-to-Business implementations, contracts and agreements may be in place to drive the specific pricing. Discounts may be applied on an incremental or time-oriented basis. A common concept used are electronic coupons or other types of discounts. The customers may have earned or acquired a coupon or other form of discount earlier in the interaction with the site. The coupon, usually stored on the user's machine, may be applied to the purchased products...")

32. With respect to Claim 79,

Mikurak discloses the following limitations

- *the proxy server processes the search result to prioritise the delivery of at least one item listed by the search result to the user in accordance with the extent to which said at least one item conforms with the set of at least one search criterion.* (see at least paragraph 883: "...When a keyword input by the user matches a feature keyword, the feature is given priority in operation 5702. Features with feature keywords having multiple matches are given highest priority and ranked according to the number of matches in operation 5703. If no keywords match, the user's words could be analyzed using a thesaurus to find keyword matches, but these would be given lower priority in operation 5704. Then, in operation 5605 of FIG. 56, a comparison table is presented with the features organized in a prioritized manner in accordance with the hierarchy. A particular item may be chosen, and similar competing items would be compared to it...")

33. With respect to Claim 80,

Mikurak discloses the following limitations

- *the proxy server alerts the user to a search result by encapsulating the search result in a small message service SMS message which is sent to the user over a communications network.* (see at least paragraph 1565: "...a dedicated email address corresponding to the user may be used when registering the product with the manufacturer, thereby providing a central location to receive notices and promotional material. If an issue with a product is found in operation 7505 such as a software bug, a factory recall or a reduced price offering, then the user is notified utilizing his defined channel such as mail, email, fax, telephone in operation 7506. If the user encounters an issue and requests support, the support will be provided utilizing the user's preferred channel and at the support level purchased by the user..")

34. With respect to Claim 81,

Mikurak discloses the following limitations

- *the search request is generated by the user terminal modifying a previously stored search request in accordance with an updated set of at least one search criterion* (see at least paragraph 1072: "...Another aspect of the electronic commerce component of the present invention has the purpose of capturing interest in a product, service, or promotion. The invention sends leads, notices, and advertisements to sales effectiveness systems where the leads are displayed or disseminated to users. A database of the leads may be kept and updated as desired...")

35. With respect to Claim 82,

Mikurak discloses the following limitations

- *the set of at least one user preferences specifies a maximum time limit for the search results to be generated.*(see at least Figure 4, paragraph 205: "...Each benefit area includes a number of associated benefits. Illustrative benefits associated with revenue enhancement 402 include: (a) faster time to site integration; (b) better on-line network performance; (c) rapid integration of acquisition; and (d) faster order to cash...."; paragraph 282: "...The new traffic (voice and video) is delivery time sensitive..."; paragraph 290: "...Such architectures address the two portions of the communications problem, one being that the delivery of data by an end user to the communication network should be such that the data arriving at the destination is correct and timely, and the other being that the delivered data must be recognizable and in proper form for use. These two portions are handled by protocols, or standard conventions for communication intelligently, the first by network protocols and the second by higher level protocols. Each of these protocols has a series of layers...")

36. With respect to Claim 83,

Mikurak discloses the following limitations

- *the distributed computer system is connected over a communications network.*(see at least paragraph 375: "...These components have been designed to operate in a distributed network environment to increase the flexibility of the NGN and New Core. The architecture provides a robust, secure and isolated messaging infrastructure for delivering control plane information to these devices..."; referring to the Rules Database Server, paragraph 396: "...This process or application is critical since it is the "glue" between the end user application and the communications network. It is responsible for collection and distribution of end-user session preferences, application requirements, access device capability and accounting policy information to the required "IN enabling" components. In summary its main functions are to: [0397] Create the AMA /CDR and other usage records [0398] Interfaces external 3.sup.rd party Network Gateways. [0399] Liase with Clearing Houses and Cross Network Location Registers [0400] Feeds the Financial Infrastructure Cross Network (Roaming) Location Register (Policy Management...")

37. With respect to Claim 84,

Mikurak discloses the following limitations

- *the session during which software provided on the user terminal interfaces with software provided on the proxy server to send the proxy server the search request message is terminated when the proxy server sends the search result message to the user.* (see at least paragraph 733: "...Another data mining classifier technique solves the memory constraint problem and simultaneously improve execution time by partitioning the data into subsets that fit in the memory and developing classifiers for the subsets in parallel. The output of the classifiers are then combined using various algorithms to obtain the final classification...")

38. With respect to Claim 85,

Mikurak discloses the following limitations

- *a user terminal arranged to be operable by a user for use in generating a search request according to the method of claim 57.* (see at least Figure 1, and 28, paragraph 41: "...FIG. 28 is a block diagram of an exemplary computer system in accordance with a preferred embodiment.."; paragraph 155: "...the present invention may be practiced in the context of a personal computer such as an IBM compatible personal computer, Apple Macintosh computer or UNIX based workstation...")

39. With respect to Claim 87,

Mikurak discloses the following limitations

- *a suite of computer programs arranged to implement a method according to claim 57, the suite of computers being provided on the distributed computer system* (see at least paragraph 375: "...These components have been designed to operate in a distributed network environment to increase the flexibility of the NGN and New Core. The architecture provides a robust, secure and isolated messaging infrastructure for delivering control plane information to these devices..."; referring to the Rules Database Server, paragraph 396: "...This process or application is critical since it is the "glue" between the end user application and the communications network. It is responsible for collection and distribution of end-user session preferences, application requirements, access device capability and accounting policy information to the required "IN enabling" components. In summary its main functions are to: [0397] Create the AMA /CDR and other usage records [0398] Interfaces external 3.sup.rd party Network Gateways. [0399] Liase with Clearing Houses and Cross Network Location Registers [0400] Feeds the Financial Infrastructure Cross Network (Roaming) Location Register (Policy Management...")

40. With respect to Claim 88,

Mikurak discloses the following limitations

- *a signal carrying a search request generated by a method according to claim 57 over a communications network comprising the distributed computer system* (see at least paragraph 255: "...When a request for an order is received from a service provider in operation 902, the request is subsequently transmitted to one or more manufacturers in operation 904. A network is utilized in operation 906 to receive information from the manufacturer relating to the status of the completing of the order by the manufacturer...")

41. With respect to Claim 89,

Mikurak discloses the following limitations

- *a signal carrying a search result generated by a method according to claim 57 communications network comprising the distributed computer system.* (see at least paragraph 255: "...A network is utilized in operation 906 to receive information from the manufacturer relating to the status of the completing of the order by the manufacturer. The manufacture's progress in completing the order is tracked in operation 908 based on the information received from the manufacturer. Periodic progress reports are generated from the tracking and then transmitted to the service provider utilizing the network in operations 910 and 912...")

42. With respect to Claim 90,

Mikurak discloses the following limitations

- *a communications network arranged to communicate a signal according to claim 88* (see at least paragraph 231: "...SONET is both a standard and a set of specifications for building high speed, digital communications networks that run over fiberoptic cables while interfacing with existing electrical protocols and asynchronous transmission

equipment..."; paragraph 231 "...SONET specifies a digital hierarchy based on Optical Carrier (OC) rather than electrical levels. SONET does define Synchronous Transport Signals (STS), however, which are electrical interfaces used as the multiplexing mechanisms within SONET Network Elements (NE)...")

43. With respect to Claim 91,

Mikurak discloses the following limitations

- *performing a search for the item and associated cost information according to claim 57, wherein the proxy server automatically provides the server software at a site indicated in the search result as able to provide the item requested by the search request with information derived from the user's preferences, the information including: sufficient financial information to enable the user to purchase the item; (see at least figure 143, paragraph 153: "...FIG. 143 is a block diagram of a bill pay system where billers initiate automatic debits from consumers' bank accounts;..."); paragraph 914: "...The Automated Clearing House ("ACH") where a user can enter a pre-authorized code and download information with billing occurring later, and a Point Of Sale (POS) system where a transaction is processed by connecting with a central computer for authorization for the transaction granted or denied immediately are examples of EFT systems that are utilized by retail and commercial organizations..."; paragraph 2662: "...Secure web server authenticates user and displays order and credit card information...")*
- *sufficient address information to enable the item to be sent to an address designated by the user. (see at least paragraph 982: "...User information is collected for order processing, including an address for delivery and billing...")*

44. With respect to Claims 93-95,

Mikurak discloses the following limitations

- *discounting the cost of the item returned by the search by a predetermined amount in accordance with a discount rule determined by the proxy server.*
- *a method as claimed in claim 93, wherein, when an item is purchased, a user preference is updated to reflect a predetermined number of points which can be indicated by the user in at least one future search request for an item and associated cost information.*
(see at least paragraph 2379: "...site members would receive discounts and additional privileges, thus building a better relationship with the site. Incentives like frequent shopper points or access to member only information are other common methods. The loyalty programs may require additional logic for permissions and content filtering. Most of this may be implemented by gathering and using profiles and integration with a complex personalization system..."; claim 13: "...using the status of the service to predict future demand by the service provider for equipment offering supplied by a manufacturer; and (d) determining production capacity, inventory, costs and discounts of manufacturer offerings based on the status of the service...")

Claim Rejections - 35 USC § 103

45. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

46. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- (a) Determining the scope and contents of the prior art.
- (b) Ascertaining the differences between the prior art and the claims at issue.
- (c) Resolving the level of ordinary skill in the pertinent art.
- (d) Considering objective evidence present in the application indicating obviousness or nonobviousness.

47. Claim 92 is rejected as being unpatentable over Mikurak, in view Sternlicht, US Patent Application Publication No US 2007/0038476 A1.

48. With respect to Claim 92,
Mikurak discloses all of the limitations described above. Mikurak does not disclose the following limitations, but Sternlicht however as shown discloses the following:

- *the items to be purchased are sent to a postal address.*(see at least paragraph 79: "...The referral source name may be a title institution name, or any unique identifier of the referral source. The location may be metropolitan identifier, city name, or any unique identifier of the location of the referral source. The address may be a postal address, street, city, state, and/or zip code identifying the address of the referral source...")

It would have been obvious to one ordinarily skilled in the art to combine the networked based e commerce technology sharing system of Mikurak with the method manager, specifically the referral source information because postal addresses would provide a more efficient means for shipping and tracking products purchased.

Conclusion

49. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Kimberly L. Evans** whose telephone number is **571.270.3929**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **John Weiss** can be reached at **571.272.6812**.
50. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free). Any response to this action should be mailed to: **Commissioner of Patents and Trademarks**, P.O. Box 1450, Alexandria, VA 22313-1450 or faxed to **571-273-8300**. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**: Randolph Building 401 Dulany Street, Alexandria, VA 22314.

/Kimberly Evans/Examiner, Art Unit 3629

June 23, 2008

/Naresh Vig/
Primary Examiner, Art Unit 3629